



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/781,132	02/09/2001	Lawrence M. Sherman	07473-033	1690

30623 7590 10/02/2006

MINTZ, LEVIN, COHN, FERRIS, GLOVSKY
AND POPEO, P.C.
ONE FINANCIAL CENTER
BOSTON, MA 02111

EXAMINER

KOPPIKAR, VIVEK D

ART UNIT PAPER NUMBER

3626

DATE MAILED: 10/02/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/781,132

Applicant(s)

SHERMAN, LAWRENCE M.

Examiner

Vivek D. Koppikar

Art Unit

3626

– The MAILING DATE of this communication appears on the cover sheet with the correspondence address –

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 26 July 2006.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 2, 10, 11, 14, 17, 20, 26, 27, 29, 37, 38, 40-44, 49 and 65-78 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 2, 10-11, 14, 17, 20, 26-27, 29, 37-38, 40-41, 42-44, 49, 65-78 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Status of the Application

1. Claims 2, 10, 11, 14, 17, 20, 26, 27, 29, 37, 38, 40-44, 49 and 65-78 have been examined in this application. This Final Office Action is in response to the "Amendments" and "Remarks" filed on July 26, 2006.

Claim Rejections - 35 USC § 103

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

3. Claim 2, 10, 11, 14, 17, 20, 26, 27, 29, 37, 38, 40-44, and 49 are rejected under 35 U.S.C. 103(a) as being unpatentable over US Patent Number 5,845,256 to Pescitelli in view of US Patent Number 6,584,446 to Buchanan and in further view of "Manhattan Life Insurance Co." (hereinafter referred to as "Manhattan").

(A) As per claims 2, Pescitelli in view of Buchanan and Manhattan collectively teach a method for providing a simultaneous or coincident multiple death insurance policy for one person and another person, the method comprising:

identifying the persons as insured parties under the insurance policy

(Pescitelli: Col. 13, Ln. 6-15);

obtaining information regarding the persons (Pescitelli: Col. 13, Ln. 6-15);

entering information regarding the persons into a data processing apparatus and

determining in the data processing apparatus the eligibility of each of the persons by comparing information received regarding the persons with one or more standards stored in the data processing apparatus (Pescitelli: Col. 3, Ln. 40-50);

entering information related to a benefit amount into the data processing apparatus (Pescitelli: Col. 8, Ln. 27-49);

entering information related to at least one beneficiary of the insurance policy into the data processing apparatus (Pescitelli: Col. 11, Ln. 21-30);

entering information related to a benefit qualification time frame into the data processing apparatus (Pescitelli: Col. 7, Ln. 56-62 and Col. 8, Ln. 1-26); and
generating the insurance policy using the data processing apparatus from the information relating to the eligible persons, the benefit amount, the at least one beneficiary, the first physical condition and the benefit qualification time frame (Pescitelli: Col. 4, Ln. 64-67)

Pescitelli does not teach that the insurance policy creates an obligation of an insurer to pay the benefit amount upon the one person assuming the first physical condition: (i) at a time the another person assumes the first physical condition, or (ii) after the another person assumes the first physical condition and within the benefit qualification time frame, however, this feature is well known in the art as evidenced by Buchanan (Col. 3, Ln. 36-48). At the time of the invention, it would have been obvious for one of ordinary skill in the art to have modified the method of Pescitelli with the aforementioned feature from Buchanan with the motivation of providing an enhanced policy for the long term care expectations for beneficiaries of an insured, as recited in Buchanan (Col. 1, Ln. 65-Col. 2, Ln. 6).

Pescitelli in view of Buchanan do not teach the following features which are taught by Manhattan (Abstract):

determining a death benefit amount based upon a probability of the simultaneous or coincident death of the persons, and a probability of the coincident death of one person and permanent incapacity of the another person within a benefit qualification time frame, the death benefit amount having a fixed value and being determined independent of other risk exposures of

either or both persons and independent of one or more other insurance benefits either or both persons are eligible for;

the confirmation of at least one of: (i) the occurrence of simultaneous or coincident death of the persons at substantially the same time or within the benefit qualification time frame, and (ii) the occurrence of death of one of the persons and the permanent incapacity of another of the persons within the benefit qualification time frame, payment of the death benefit amount being independent of one or more other benefit payments either or both persons are eligible for; and

the policy being a stand-alone policy independent in effect from other insurance benefits either or both persons are eligible for (Manhattan: Abstract).

At the time of the invention, it would have been obvious for one of ordinary skill in the art to have modified the combined teachings of Pescitelli in view of Buchanan with the aforementioned teachings from Manhattan with the motivation of having a means to provide a potential beneficiary with an insurance benefit if the beneficiary had lost two people, both of whom had insured the beneficiary, as recited in Manhattan (Abstract).

(B) As per claim 10, in the combined method of Pescitelli in view of Buchanan and in view of Manhattan the at least one beneficiary is financially dependent (relative) upon at least one of the persons (Pescitelli: Figure 4G and Col. 11, Ln. 21-30).

(C) As per claim 11, in the combined method of Pescitelli in view of Buchanan and in view of Manhattan the step of obtaining information regarding the persons includes obtaining responses to one or more questions (Pescitelli: Col. 2, Ln. 62-Col. 3, Ln. 14).

(D) As per claim 13, in the combined method of Pescitelli in view of Buchanan and in view of Manhattan the insurance policy includes a term to designate a period of time the insurance policy is effective (Pescitelli: Col. 7, Ln. 56-62 and Col. 8, Ln. 1-26).

(E) As per claims 14, 17, 20, 26-27, 29, 37-38, 40-44, 49, 72-73 and 78 these claims repeat features previously addressed in the rejection of claims 2, 10-11 and 13 and are rejected on the same basis.

(F) As per claim 65, the combined teachings of Pescitelli in view of Buchanan and in view of Manhattan comprising generating the insurance policy creating an obligation of the insurer to pay a principal portion of the fixed value of the benefit amount upon the confirmation of the occurrence of death of the one person and a residual portion of the fixed value of the benefit amount upon the confirmation of the occurrence of permanent incapacity of the another person (Manhattan: Abstract). The motivation for making this modification to the teachings of Pescitelli is the same as set forth in the rejection of Claim 2, above.

(G) As per claims 66 and 70 in the combined teachings of Pescitelli in view of Buchanan and in view of Manhattan the principal portion of the fixed value of the benefit amount is not explicitly less than the residual portion of the fixed value of the benefit amount, however, the examiner takes the Official Notice that it is well known in the insurance industry for a policy to offer various benefits which have differing benefit amounts and at the time of the invention it would have been obvious for one of ordinary skill in the art to have offered a supplemental benefit as a means of making an insurance policy more attractive to potential insureds as compared to other insurance policies on the market.

(H) As per claims 67 and 71, 74 and 75, in the combined teachings of Pescitelli in view of Buchanan and in view of Manhattan the benefit qualification time frame includes a specified period of time selected from the group consisting of twenty four hours, forty eight hours, seven days, thirty days, one year, two years, and three years (Manhattan: Abstract). The motivation for making this modification to the teachings of Pescitelli is the same as set forth in the rejection of Claim 2, above.

(I) As per claims 68 and 76, the combined teachings of Pescitelli in view of Buchanan and in view of Manhattan teach the step of generating the insurance policy further comprises creating an obligation of the insurer to pay the death benefit amount upon the confirmation of the occurrence of death of one of the persons and death of another of the persons within the benefit qualification time frame (Manhattan: Abstract). The motivation for making this modification to the teachings of Pescitelli is the same as set forth in the rejection of Claim 2, above.

(J) As per claim 69, the combined teachings of Pescitelli in view of Buchanan and in view of Manhattan teach the step of generating the insurance policy and creating an obligation of the insurer to pay a principal portion of the fixed value of the benefit amount upon the confirmation of the occurrence of death of the one person and a residual portion of the fixed value of the benefit amount upon the confirmation of the occurrence of death of the another person within the benefit qualification time frame (Manhattan: Abstract). The motivation for making this modification to the teachings of Pescitelli is the same as set forth in the rejection of Claim 2, above.

(K) As per claim 77, the combined teachings of Pescitelli in view of Buchanan and in view of Manhattan teach a step of determining the death benefit amount and this step includes

Art Unit: 3626

determining the death benefit based upon at least one of: (i) a probability of the simultaneous or coincident death of the persons at substantially the same time, and (ii) a probability of the coincident death of one person and permanent incapacity of the another person within the benefit qualification time frame (Manhattan: Abstract). The motivation for making this modification to the teachings of Pescitelli is the same as set forth in the rejection of Claim 2, above.

Response to Arguments

4. Applicant's arguments filed on July 26, 2006 with respect to the pending claims have been considered but are moot in view of the new ground of rejection.

Conclusion

5. Applicant's amendment necessitated the new ground of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).


A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Art Unit: 3626

6. Any inquire concerning this communication or earlier communications from the examiner should be directed to Vivek Koppikar, whose telephone number is (571) 272-5109. The examiner can normally be reached from Monday to Friday between 8 AM and 4:30 PM.

If any attempt to reach the examiner by telephone is unsuccessful, the examiner's supervisor, Joseph Thomas, can be reached at (571) 272-6776. The fax telephone numbers for this group are either (571) 273-8300 or (703) 872-9326 (for official communications including After Final communications labeled "Box AF").

Another resource that is available to applicants is the Patent Application Information Retrieval (PAIR). Information regarding the status of an application can be obtained from the (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAX. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, please feel free to contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Sincerely, 
Vivek Koppikar

9/19/2006


JOSEPH THOMAS
SUPERVISORY PATENT EXAMINER